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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,179	02/16/2001	Veronique Chevalier	202443US0	3089

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OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT PC
FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

EXAMINER

WILLIS, MICHAEL A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 12/18/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,179

Applicant(s)

CHEVALIER ET AL.

Examiner

Michael A. Willis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Applicant's response of 2 October 2002 is entered. Claims 1-23 are pending. Any previous rejections that are not restated in this Office Action are hereby withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Claims 1-22 are rejected under 35 USC 103(a) as being unpatentable over Philippe et al (WO 99/10318) for reasons as stated previously.

Applicant argues that none of the examples disclose a combination of an aminophenol compound with another compound having skin depigmenting activity. However, such a disclosure is not necessary for a rejection under 35 USC 103(a), particularly where Philippe provides the motivation for making such a combination which allows the agent such as hydroquinone to be used at doses that are less toxic to the skin. It is noted that Philippe does disclose the combination of an aminophenol compound and another depigmenting agent in claim 8 of the reference.

Applicant argues that the reference shows that the N-ethyloxycarbonyl derivative of Example 1 is ten times more effective than the N-cholesteryloxycarbonyl derivative of Example 3. Applicant suggests that therefore one of ordinary skill in the art would look to the N-ethyloxycarbonyl derivative rather than the N-cholesteryloxycarbonyl derivative of the instant claims. This is not found persuasive because preferred embodiments do not constitute a teaching which is away from a broader disclosure or nonpreferred

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embodiments. *In re Susi*, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

Finally, applicant argues that Examples 1 and 2 of the present specification demonstrate unexpected results. The reasons provided by the applicant are similar in nature to the reasons presented previously. However, the conclusions made by the applicant are not supported by the data presented. A conclusion of the broad superiority of the N-cholesteryloxycarbonyl derivative over the N-ethyloxycarbonyl derivative when combined with hydroquinone cannot be made on the basis of the data presented in Examples 1 and 2 of the specification because the differing conditions of the examples do not allow a comparison, as stated previously. Applicant's assertions to the contrary are not convincing.

Claims 1-11 and 23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14, 18, and 21 of US Pat. 6,423,854 B1 (Application No. 09/284,490) for reasons as stated previously. Since the co-pending application issued as a patent in the time since the previous Office Action, the previous rejection is no longer provisional.

Applicant argues that none of the claims describe or suggest the combination of an aminophenol compound with a hydroquinone compound as claimed. Applicant's argument is not convincing in that claim 21 of the patent claims an aminophenol

derivative with a cholesteryl radical that is identical to the instantly claimed N-cholesteryloxycarbonyl compound, and claim 18 of the patent claims a composition comprising the combination of the aminophenol compound and other depigmenting agents, where other depigmenting agents are defined as including hydroquinone and its derivatives.

The double patenting rejection can be overcome by a Terminal Disclaimer.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

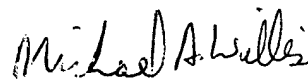
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on alt. Mondays and Tuesday to Friday (9am-6:30pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703) 305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael A. Willis
Examiner
Art Unit 1617

maw
December 12, 2002



SREENI PADMANABHAN
PRIMARY EXAMINER

12/13/02